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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,240	01/19/2005	Iain Frank Fraser	II/2-2278/MA2223/PCT	8341

324 7590 10/12/2006

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EXAMINER
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KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/523,240

**Applicant(s)**

FRASER ET AL.

**Examiner**

Helene Klemanski

**Art Unit**

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, 22-28 and 34-38 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 12-21, 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/22/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-7, 9-16, 18, 19, 25, 28 and 36 have been amended, claims 31-33 have been deleted and new claims 37-38 have been added. Hence, claims 1-30 and 34-38 are pending in the application.

### ***Information Disclosure Statement***

2. The references cited in the Search Report dated November 2, 2003 have been considered.

### ***Claim Objections***

3. Claims 6, 18, 19 and 22-29 are objected to because of the following informalities: in claim 6, line 4, the term "(non-polar)" should be deleted; also in claim 6, line 5, the term "(acrylate monomers)" should be deleted; in claim 18, line 5, the term "(acrylate monomers)" should be deleted; in claim 19, line 4, the term "form" should be replaced with the term "from" and in claims 22-29, the term "(resin)" should be deleted.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

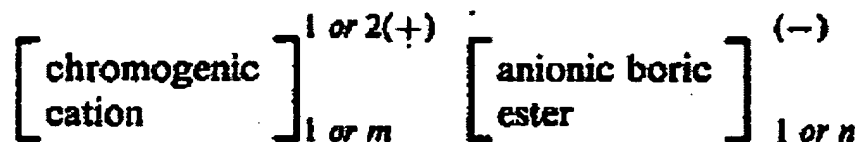
A person shall be entitled to a patent unless –

Art Unit: 1755

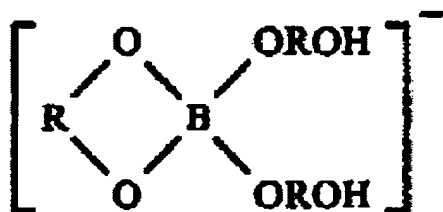
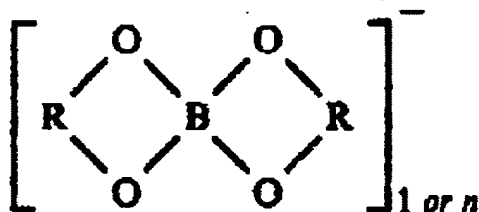
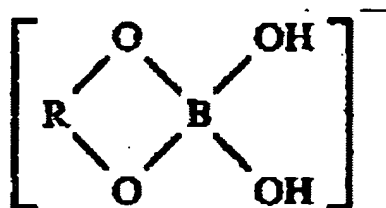
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 6, 8-11, 22-28 and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by De Feo et al. (US 4,306,875).

De Feo et al. teach water-insoluble salts of basic dyes with good solubility in organic solvents comprising a basic dye of the formula



wherein the chromogenic cation is a residue of a basic dye such as Basic Yellow 11 (i.e. cationic dye of the formula as claimed by applicants) and the anionic boric acid ester is represented by the formula



wherein R is the residue of an aliphatic alpha, beta-diol or of an aromatic orthodiol which can be further substituted or the residue of an aliphatic alpha-hydroxy-carboxylic acid or of an aromatic ortho-hydroxy-carboxylic acid which can be further substituted (i.e. organic anion). De Feo et al. further teaches that the above water-insoluble dyes are useful in printing lacquers and ink compositions such as solvent and water flexographic inks, off-set and rotogravure printing inks and inks for ball point pens and inking pads. See col. 1, lines 53-55, col. 2, lines 18-55, col. 3, line 50 – col. 4, line 6, col. 5, lines 40-45, col. 7, lines 16-20, examples 3, 4 and 22 and claims 1-4. The water-insoluble salts of basic dyes and ink compositions containing the water-insoluble salts of the basic dyes as taught by De Feo et al. appear to anticipate the present claims.

***Allowable Subject Matter***

6. Claims 4, 7, 12-21, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: None of the cited prior art teaches or fairly suggests: (1) a basic dye of the formula as claimed by applicants wherein  $R_1$ - $R_4$  are methyl;  $R_5$  is methyl or methoxy when  $m$  is 1, or two  $R_5$  together form  $-O-CH_2-O-CH_2-$ ;  $R_6$  is H and  $n$  is 1; (2) wherein the resin acid is an organo-soluble acid selected from the group consisting of rosin acid, abietyl acid, colophony or derivatives thereof; (3) a process for preparing a printing ink composition comprising mixing together at least one carbinol dye precursor of the formula as claimed by applicants an organic resin acid dissolved in an organic solvent and optionally a pigment and (4) extruding the carbinol dye, the organic resin acid and optionally the pigment mixture into high solids dispersion, solutions or pastes of the ink vehicles as claimed by applicants.

***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
October 1, 2006